

REMARKS

I. Introduction

With the addition of new claim 29, claims 15 to 29 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited reference.

II. Rejection of Claims 15 to 21 and 25 Under 35 U.S.C. § 102(b)

Claims 15 to 21 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,469,215 ("Nashiki"). Applicants respectfully submit that Nashiki does not anticipate the present claims for the following reasons.

Claim 15 relates to a device for monitoring at least one measuring system for detecting at least one measured quantity of an electric drive, including at least one controller for receiving the at least one measured quantity detected by the at least one measuring system and for generating at least one manipulated variable for controlling the electric drive. Claim 15 recites that the device includes at least one signal processor for detecting an error in the at least one measuring system.

Nashiki purports to relate to a method and apparatus for controlling an electric motor. The Office Action at pages 2 to 3 contains general allegations regarding the disclosure of Nashiki. However, the Office Action fails to even allege that Nashiki discloses a "device for monitoring at least one measuring system for detecting at least one measured quantity of an electric drive, including at least one controller for receiving the at least one measured quantity detected by the at least one measuring system and for generating at least one manipulated variable for controlling the electric drive" as recited in claim 15, and the Office Action fails to even allege that Nashiki discloses that a "device includes at least one signal

processor for detecting an error in the at least one measuring system" as recited in claim 15. Indeed, it is respectfully submitted that Nashiki fails to disclose, or even suggest, a "device for monitoring at least one measuring system for detecting at least one measured quantity of an electric drive, including at least one controller for receiving the at least one measured quantity detected by the at least one measuring system and for generating at least one manipulated variable for controlling the electric drive" or that such a device "includes at least one signal processor for detecting an error in the at least one measuring system" as recited in claim 15.

In contrast, Nashiki apparently relate to "an electric motor control system for compensating the rotation error in an electric motor operated by a given torque command." Col. 3, lines 3 to 4. However, the foregoing does not constitute a disclosure, or even a suggestion, of a "device for monitoring at least one measuring system for detecting at least one measured quantity of an electric drive, including at least one controller for receiving the at least one measured quantity detected by the at least one measuring system and for generating at least one manipulated variable for controlling the electric drive" as recited in claim 15, and the foregoing does not constitute a disclosure, or even a suggestion, that such a "device includes at least one signal processor for detecting an error in the at least one measuring system" as recited in claim 15.

Furthermore, the general allegations contained on pages 2 to 3 of the Office Action regarding the disclosure of Nashiki are irrelevant to the patentability of the present claims since those general allegations do not even refer to the limitations set forth in the present claims.

It is "well settled that the burden of establishing a prima facie case of anticipation resides with the [United States] Patent and Trademark Office." Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788-89 (Bd. Pat. App. & Inter. 1986) (citing In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim."

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Nashiki does not disclose, or even suggest, a "device for monitoring at least one measuring system for detecting at least one measured quantity of an electric drive, including at least one controller for receiving the at least one measured quantity detected by the at least one measuring system and for generating at least one manipulated variable for controlling the electric drive" as recited in claim 15 or that such a "device includes at least one signal processor for detecting an error in the at least one measuring system" as recited in claim 15. It is therefore respectfully submitted that Nashiki does not anticipate claim 15.

Moreover, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that Nashiki does not anticipate claim 15.

As for claims 16 to 21 and 25, which ultimately depend from claim 15 and therefore include all of the limitations of claim 15, it is respectfully submitted that Nashiki does not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 15.

III. Rejection of Claims 22 to 24 and 26 to 28 Under 35 U.S.C. § 103(a)

Claims 22 to 24 and 26 to 28 were rejected under 35 U.S.C. § 103(a) as unpatentable over Nashiki. Applicants respectfully submit that Nashiki does not render obvious the present claims for the following reasons.

As an initial matter, claims 22 to 24 and 26 to 28 ultimately depend from claim 15 and therefore include all of the limitations of claim 15. As more fully set forth above, Nashiki does not disclose, or even suggest, all of the limitations of claim 15. It is therefore respectfully submitted that claims 22 to 24 and 26 to 28 are patentable over Nashiki. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (any dependent claim that depends from a non-obvious independent claim is non-obvious).

As regards the present rejection, the Office Action merely alleges that "Nashiki teaching can be applied to a control system for a 3-phase ac motor performing two-to-three phase conversion and further to any other control system for multi-phase, multi-pole motors, dc motors and induction motors." Office Action at pp. 3 to 4. However, these contentions are entirely irrelevant to the patentability of the present claims.

In this regard, claim 22 recites that "a measuring system model generates at least one expected estimate for the at least one measuring system for providing error detection in the measuring system." The Office Action does not even allege that this limitation is disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, this limitation.

As regards claim 23, claim 23 recites that "a reversing switch relays an error signal of the at least one signal processor as a function of the at least one expected estimate." The Office Action does not even allege that this limitation is

disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, this limitation.

As regards claim 24, claim 24 recites that "the at least one signal processor is activatable as a function of at least one of a quantity generated by the at least one controller, and another quantity generated by the at least one controller when it assumes at least one of a certain value and a maximum allowed set point." The Office Action does not even allege that these limitations are disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, these limitations.

As regards claim 26, claim 26 recites that the device includes "a selector device for making a selection between a first error monitoring and a second error monitoring as a function of a selection quantity." The Office Action does not even allege that this limitation is disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, this limitation.

As regards claim 27, claim 27 recites that "the selector device makes a selection between the first error monitoring and the second error monitoring as a function of at least one expected estimate for the at least one measuring system." The Office Action does not even allege that this limitation is disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, this limitation.

As regards claim 28, claim 28 recites that "the measuring system model forms the at least one expected estimate as a function of at least one controller quantity that is at least one of generated by the at least one controller and a function of the at least one controller." The Office Action does not even allege that this limitation is disclosed or suggested by Nashiki. Indeed, it is respectfully submitted that Nashiki does not disclose, or even suggest, this limitation.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine,

supra. This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, Nashiki does not disclose, or even suggest, all of the limitations of claim 15, from which claims 22 to 24 and 26 to 28 ultimately depend. It is therefore respectfully submitted that Nashiki does not render obvious claims 22 to 24 and 26 to 28, which ultimately depend from claim 15.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects, at best, a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so,

found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did

not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the reference relied upon, whether taken alone, combined or modified, would provide the features and benefits of claims 22 to 24 and 26 to 28, which ultimately depend from claim 15. It is therefore respectfully submitted that claims 22 to 24 and 26 to 28 are allowable for these reasons.

IV. New Claim 29

Claim 29 has been added herein. It is respectfully submitted that new claim 29 does not add any new matter and is fully supported by the present application, including the Specification. It is respectfully submitted that claim 29 is allowable.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: 4/15/03

By: Richard L. Mayer

Richard L. Mayer
Reg. No. 22,490

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646



26646

PATENT TRADEMARK OFFICE